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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,389	12/10/2003	Robert H. Lamber	5448	4670

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EXAMINER
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SUHOL, DMITRY

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 08/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

7/10/05

<b>Office Action Summary</b>	<b>Application No.</b> 10/731,389	<b>Applicant(s)</b> LAMBER, ROBERT H.	
	<b>Examiner</b> Dmitry Suhol	<b>Art Unit</b> 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 and 9-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1, 14 and 18, the limitations of the encirclement being sized to overlie substantially only the end-most phalange of the user's/child's finger and the encirclement being constrained to be fixed in a non-rotative position on the finger were not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no teaching in the disclosure of the above limitations.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 11 and 16, the features encompassed by the term orthogonal screen appearance can't be determined. It is not clear relative to what is the magnetic insert orthogonal and it is not clear what structural limitations are encompassed by the term screen.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Calvert '437. Calvert discloses a sewing thimble containing all of the claimed elements including, a finger tip encirclement worn on a finger (figures 1 and 3) as required by claim 1, having a rubbing surface/discernible point of attention positioned thereon to be rubbed between at least two fingers (surface 16) as required by claim 1.

Regarding the particular finger that the encirclement is worn on as required by claims 2-3, since Calvert clearly states that his device accommodates a range of different finger sizes (col. 1, lines 59-61) it is inherently capable of being worn any finger desired by the user.

Regarding the materials of manufacture as required by claims 4-7 (i.e. natural leather), Calvert discloses that his device is made of a natural leather (col. 2, lines 66+ and col. 3, lines 1-10).

Regarding the limitations of the encirclement being sized to overlie substantially only the end-most phalange of the user's finger and the encirclement being constrained to be fixed in a non-rotative position on the finger, it is the position of the examiner that both limitations are met by the device of Calvert.

Claims 1-7 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Calvert '059. Calvert discloses a sewing thimble containing all of the claimed elements including, a finger tip encirclement worn on a finger (thimble 2) as required by claim 1, having a rubbing surface positioned thereon to be rubbed between at least two fingers (top surface of body 4 holding member 14) as required by claim 1.

Regarding the particular finger that the encirclement is worn on as required by claims 2-3, since Calvert clearly states that his device accommodates a range of different finger sizes (col. 1, lines 45-46) it is inherently capable of being worn any finger desired by the user.

Regarding the materials of manufacture as required by claims 4-7 (i.e. natural leather), Calvert discloses that his device is made of a natural leather (col. 3, lines 39-42).

A surface having discernible point of attention smooth to tapping or rotational touch, as required by claims 1 and 9, is shown as element 14 and described at col. 4, lines 1-2.

Regarding the limitations of the encirclement being sized to overlie substantially only the end-most phalange of the user's finger and the encirclement being constrained to be fixed in a non-rotative position on the finger, it is the position of the examiner that both limitations are met by the device of Calvert.

Claims 14 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Cao '186. Cao discloses a finger strap containing all of the claimed elements including with respect to claims 14 and 18, a finger tip encirclement (2) worn on one of the index, middle, ring, and little fingers (figure 4) having a magnetic rubbing surface (element 1, paragraph 0013).

Regarding the limitations of the encirclement being sized to overlie substantially only the end-most phalange of the user's/child's finger and the encirclement being constrained to be fixed in a non-rotative position on the finger, it is the position of the examiner that both limitations are met by the device of Cao.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Calvert '059 in view of Brull '515. Calvert discloses all of the claimed elements, as stated above, and further including that small insert (14) maybe permanently attached (stitching 16 and col. 3, lines 65-67), as required by claim 15, and face the users palm when worn on the desired finger (inherent), as required by claim 13. As best understood insert 14 encompasses a flat, substantially orthogonal screen appearance as required by claims 11 and 16.

Calvert fails to teach that his member 14 is magnetic as required by claims 10-13. However, Brull discloses a device like that of Calvert which teaches that it is known to provide the protective surface (12) of such devices with a magnetic layer (16) like common refrigerator magnets (known to be black colored and have minimal strength). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have provided protective member 14 of Calvert with a magnetic layer for the purpose of allowing the user of the thimble to retrieve objects without requiring the tip of the user's finger to contact the object being retrieved.

### ***Response to Arguments***

Applicant's arguments filed June 10<sup>th</sup>, 2005 have been fully considered but they are not persuasive. It appears that Applicants argue that the function of the Calvert and Cao references is different than their function. In response the examiner points out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). In this case applicants invention is merely a device with structural features of a magnetic thimble which is used to rub between ones fingers, in which case the above references and associated combination of references encompass all of the claimed structure and therefore obviate or anticipate applicants device.

Furthermore, it is pointed out that all of the above references are worn on the upper phalange of a users finger and are not meant to be rotated since otherwise they would not function as intended.

Additionally, as stated above, it is believed that the Calvert '059 or the combination of Calvert '059 and Brull '515 encompass all of claimed limitations, as stated above.

### **Conclusion**



**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3725

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dmitry Suhol  
Examiner  
Art Unit 3725

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